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Yoshiyuki Sasaki

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

06/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/058,029	Applicant(s) SASAKI, YOSHIYUKI	
	Examiner JORGE L. ORTIZ CRIADO	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification /Drawings

The amendment filed 12/14/2007 or substitute filed 01/14/2008 are objected to under 35 U.S.C. 132(a) because it introduced new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendments made to Figures drawings 6- 11, in the steps “s3” and “s4” of “Suitable for User’s request” and “Changing speed of spindle motor”, respectively, introduces New Matter.

The examiner cannot ascertain where in the original specification, including the detailed description, support for these changes to the drawings is found. The description found in the corresponding explanation in the specification, and the drawings interpreted along with the accompanying description, describes at page 6, line 10-21 is as follows:

“Formatting in the background begins (Step S1). The controller 13 checks whether the user requests to store or reproduce data (Step S2). If the user requests to do so (Y branch of S2), the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user's request (S3). If the disc is not rotating at a speed corresponding to the speed of storage and reproduction designated by the user (N branch of S3), the controller 13 changes the rotating speed of the spindle motor 4 through the rotation control unit 10 (S4)”.

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Hence, the supporting description relates to changing the rotation by checking whether the disc is rotating at a speed corresponding to the speed of storage and reproduction designated by the user request (emphasis added), and the controller controls and changes the rotation speed of the spindle motor through a rotation control unit (See for example Figure. 6 step S3 and the description on page 16, lines 6-24).

Hence, this new features added to the figures represents new matter added to the disclosure as amended to the figure drawings, and finds no support in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims newly recite the limitation “if the first rotation mode is **not suitable** for the storing and reproducing of the user's request, changing from the first rotating mode to a second rotating mode and writing the user data to the recording medium at the second rotating mode”.

The examiner cannot ascertain where in the specification, including the detailed description and the drawings, support for this limitation is found. The only description found related to changing the rotation is related to the controller checking whether the disc is rotating at a speed corresponding to the speed of storage and reproduction **designated** by the user request, and the controller controls and changes the rotation speed of the spindle motor through a rotation control unit (See for example explanation for Figure 6, on page 16, lines 6-24). No determination is made to change from the first rotating mode to a second rotating mode and writing the user data to the recording medium at the second rotating mode, if the first rotation mode is not suitable for the storing and reproducing of the user's request.

The currently amended Figures are not considered supporting, because as outlined above the changes introduce new matter added.

The specification describes changing the speed to that requested by the user. Hence, this new limitation represents new matter added to the claims.

Response to Arguments

Applicant's arguments filed 03/07/2008 have been fully considered but they are not persuasive.

Applicant argues that the Drawings do not introduce new matter to the Specification, because the amendments were submitted by Applicant to obviate Examiner objection to the original drawings. Applicant argues that the amended drawings modify the labeling on steps S3 and S4 on each of the flow charts of Figs. 6-11 and these changes are fully disclosed by the original specification.

The Examiner cannot concur with the Applicant because the amendment to the drawings introduces subject matter of "determining if the first rotation mode is not suitable for the storing and reproducing of the user's request", which is not supported by the original disclosure.

And as clearly set forth in the specification, regarding steps S3 and S4, as originally filed, the only description found is recited as follows "*the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user's request (S3). If the disc is not rotating at a speed corresponding to the speed of storage and reproduction designated by the user (N branch of S3), the controller 13 changes the rotating speed of the spindle motor 4 through the rotation control unit 10 (S4)*".

Applicant argues that the user request does not designate the specific rotation speed during the storage and reproduction processes.

The examiner cannot concur and disagrees with the Applicant because the expressly recitation from the specification original originally filed is as follows: "*If the disc is not rotating at a speed corresponding to the speed of storage and reproduction designated by the user (N*

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branch of S3)”. Hence, contrary to the Applicant assertions the user does designate the specific rotation speed during the storage and reproduction processes. The user requests the recording and/or reproduction and designate the speed as clearly explained.

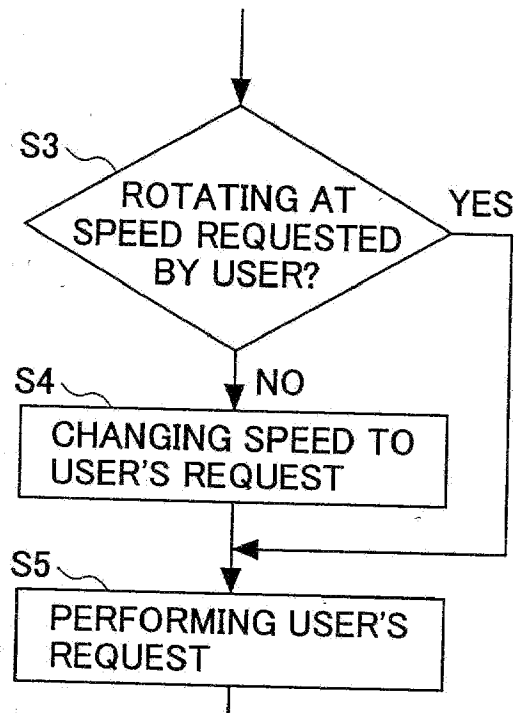
Applicant argues that there is a mistaken misreading of the cited written description, however the whole portion considered in full does not provides for the contrary and is absolutely not considered selectively.

On the contrary, it appears that the Applicant is selectively reading half the portion describing the steps S3 and S4 from the specification and is selecting only the portion that recites “suitable” and completely not considering the remaining description provided, as originally filed in the specification.

Applicant argues that the claims also supported by the original disclosure. Applicant argues that for the same reasons that the portions of the specification are misread. Applicant argues that the specification provides for “the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user's request (S3)” and not whether the disc is rotating at a speed designated by the user.

However, contrary to the Applicant's assertion the Drawings as originally filed, and the specification, as originally filed, provides for whether the disc is rotating at a speed designated by the user, as outlined above.

The specification and the Drawings as originally filed provides for the user requesting the speed. See for example a portion of Applicant's originally filed Figure Drawing 6.



As shown in the Figure step S3 expressly, clear and concise "rotating at speed requested by user" and further in step S4 "changing speed to user's request".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE L. ORTIZ CRIADO whose telephone number is (571)272-7624. The examiner can normally be reached on Mon.-Fri 10:00 am- 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/
Patent Examiner, Art Unit 2627